

REMARKS

Claims 1-8 were pending.

Claims 1-8 are rejected.

Claims 1-3 are cancelled.

Claim 4-8 are amended.

Claims 4-8 are pending.

Amended Claims 4-8

Claim 4 is amended to include the formula (I) and component b) of deleted claim 1.

Claims 5-8 are amended to change the dependency to claim 4 as claim 1 is cancelled.

No new matter is added.

35 USC 103(a)

Claims 1-8 are rejected under 35 USC 103(a) as being unpatentable over Cox, US 4,882,077 in view of Amende, DE 2,054,649.

Claims 1-6 and 8 are rejected under 35 USC 103(a) as being unpatentable over Kubo, US 5,362,375 in view of Amende.

In order to further prosecution, applicants have narrowed the scope of the claims to reflect the formula (I) described in claim 4. This addresses the examiner's concern that the results are not commensurate with the scope of the claims.

Applicants preserve the right to recapture the broader claims in a continuation.

The applicants refer the examiner to the results given on page 21. These tests show corrosion protection properties according to ASTM D 665 of a formulated oil mixed with seawater and compounds of formula (I).

The combination of compounds of formula (I) with a base oil of lubricating viscosity clearly shows improved corrosion protection. Each test is carried out in duplicate. The base oil without the compounds of formula (I) shows a heavy corrosion rating of 3 (worst possible rating). When the base

oil is combined with compounds of formula (I) corrosion ratings of 0 or 1 are seen. This is certainly surprising and could not have been predicted based on the cited references.

Furthermore, the applicants summarize their previous arguments of June 6, 2008.

In regard to the combination of Cox with Amende:

Cox discloses metalworking fluids comprising a paraffin oil and an emulsifier but does not does not disclose the compounds of claims 1-5.

In particular, Cox teaches no amide structures of succinic acid, which is a distinctive structural embodiment. Cox teaches only diesters from adipic acid and other dibasic acids (Col. 4, lines 11-13) but no amides.

Examiner looks to Amende which discloses the preparation of a compound by the reaction of an acrylic acid ester and alkylamines such as laurylamine, stearylamine, and oleyl amine, followed by further reaction with maleic anhydride. On page 6 Amende discloses that succinic anhydride can be used in place of maleic anhydride. Amende discloses that the compound is useful as an emulsifier.

The examiner cites as the motivation to combine these two pieces of virtually unrelated art to the fact that Amende suggests the use of his reaction product as an emulsifier and Cox uses emulsifiers in his metalworking systems.

Applicants submit that there are virtually an unlimited number of emulsifiers. While it is true that Cox teaches the use of emulsifiers in metalworking fluids, Cox further teaches that although any oil-in-water emulsifier may be used but it is desirable that the emulsifier be either anionic or nonionic in nature. See col. 4, lines 20-25.

Amende describes the addition of primary amines to acrylic acid esters and the subsequent reaction with succinic anhydride and directs the product formed to textile adjuvants. This utility is unrelated with the use of the claimed compositions as lubricant compositions.

There is nothing in Cox or in Amende which would direct one skilled in the art to use the emulsifiers taught in Amende in the lubricant compositions of Cox.

Furthermore, even if there were a reason to combine these two references (and the applicants avers there is no motivation, teaching or suggestion to combine), the combination of structures of formula (I) with a base oil of lubricating viscosity give advantages that could not have been predicted based on either of the cited references.

Thus because there is no common link between the primary reference, Cox and secondary reference, Allende, there is no motivation at all to combine.

Secondly, even if there were some motivation (and applicants aver there is none), the base oil when combined with compounds of formula (I) give unobvious improved corrosion ratings as explained above.

In regard to Kubo, US 5,362,375 in view of Amende:

The applicants believe this rejection to lack merit for similar reasons as explained above in the Cox rejection.

Firstly, Kobo makes one reference to the use of emulsifiers in his oil compositions. There is no suggestion or teaching of what emulsifiers might be useful to him. See col. 4, line 66.

According to the examiner, Amende supplies the missing claim limitation for formula (I) because Amende refers to his reaction products as emulsifiers.

While the examiner is of the opinion that one skilled in the art would look to Amende, a reference which deals with an unrelated technology area (textile aduvants), and take the specific emulsifier used in this unrelated system and combine with the Kobo Oil systems, the applicants believe this to be a clear case of hindsight analysis by the examiner. Neither reference deals with related technology. Each mention the term "emulsifier" but there is no particular reason why one would select the emulsifier defined in Amende and combine with oil system of Kobo. There are many other emulsifiers which might have more readily come to mind such as emulsifiers which are known for use in oil systems.

As explained above there are many types of emulsifiers, and one would need more than just the identifier of "emulsifier" to look to Amende for combining with the oils of Kobo.

Furthermore, as explained above even if it made sense to combine these two unrelated references, the advantages of the presently claimed combinations are certainly unobvious and not suggested or taught by either cited reference. Unobvious advantages are indicators of unobviousness.


Reconsideration and withdrawal of the rejection of claims 4-8 is respectfully solicited in light of the remarks *supra*.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 4-8 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,

Ciba Specialty Chemicals Corporation
540 White Plains Road
Tarrytown, New York 10591
(914) 785-2768
SAL22745FR.doc


Shiela A. Loggins
Agent for Applicants
Reg. No. 56,221